

Response to Office Action
Ser. No. 09/674,714
May 27, 2003
Page 2

Foreign Patent Notification

The applicant wishes to notify the examiner that the present invention has now been patented in Europe (EP 1 076 879 B1) and Australia (14834/99).

Claims 1 and 2

A *prima facie* case has not been made for the rejection of claims 1 and 2. The examiner has rejected these claims on the basis that the prior art supposedly suggests “integrating” a mouse pad with a read/ write device.

But claims 1 and 2 do not require “integration” of a mouse pad with a read/ write device. Instead, these claims require that the “unit,” which includes a card read/ write device, be *“formed by a mouse pad.”* (emphasis added).

The examiner claims that it would be obvious to “integrate” the Wilson device (U.S. Des. Patent 380,462) with a read/ write device. As explained below, the applicant respectfully disagrees with this interpretation of Wilson.

But even if Wilson does suggest “integration,” it does not show a read/ write unit that is *“formed by”* a mouse pad. The mouse pad of Wilson does not “form” anything (except a mouse pad), and it certainly does not form a unit that includes a read/ write device. It is simply not true that the read/ write unit of Wilson is “formed by” a mouse pad. Nor do any of the other cited references show a unit that includes a read/ write device

Response to Office Action
Ser. No. 09/674,714
May 27, 2003
Page 3

that is formed by a mouse pad. *See* U.S. Patent No. 5,625,534 ("Okaya"), U.S. Patent No. 5,987,547 ("Panasik et al."), and U.S. Patent No. 4,799,054 ("House").

Simply put, none of the references teaches or suggests forming a read/write unit with a mouse pad, so these claims should be allowed.

Claims 3 -32

The examiner has rejected each of these claims under 35 U.S.C. § 103, relying on Wilson, Okaya, Panasik, and House. For the reasons stated below, the applicant respectfully traverses these rejections.

Failure to Teach Integration of Read/Write Device or Other Peripheral with Mouse Pad

Each of these claims contain a limitation that is not taught or suggested by the prior art, namely a read/write or other peripheral device integrated with a mouse pad.

The examiner has stated that it would have been obvious to modify the retractable mouse pad of Wilson to integrate the disk drive with the mouse pad.

But Wilson does not suggest moving the disk drive into the mouse pad, and indeed there would be little point in doing so since the Wilson computer is a notebook model, and thus the CPU will always be close to the mouse pad. The present invention provides the advantage of keeping the read/write device close at hand, even when the

Response to Office Action
Ser. No. 09/674,714
May 27, 2003
Page 4

CPU is on the floor or otherwise remote from the work area. Since no identified purpose would be served by moving the disk drive into the retractable mouse pad, this proposed modification is not obvious.

The examiner also asserts that it would be an obvious "design choice" to move the disk drive into the mouse pad, but no reference is provided for this statement. To the extent that the examiner's personal knowledge is the basis for this assertion, the applicant requests a supporting affidavit.

Additionally, the applicant traverses the unsupported assertion that it is simply a design choice whether to integrate the read/write device or not. There are several advantages in integrating the read/write device with the mouse pad. First, scarce desk space is conserved by combining two separate devices (mouse pad and read/write device) into one. Even more desk space can be conserved by integrating a number of peripheral devices into the mouse pad.

Second, integration with a mouse pad makes it easier to keep the read/write device close at hand, even if the CPU is on the floor or otherwise remote from the user.

Third, the integrated device provides new marketing opportunities. For instance, an institution, such as a bank, could provide its customers with a combination mouse pad/smart card reader to encourage use of smart cards. Advertising from the bank

Response to Office Action
Ser. No. 09/674,714
May 27, 2003
Page 5

could be placed on the top surface of the mouse pad. It would be easy for an institution to use such a device for marketing purposes, because an integrated mouse pad can be shrink-wrapped and conveniently sent as a letter, or placed in an envelope. Since the mouse pad is perceived by the end user as a marketing tool, not a hardware product, the institution that distributes the device does not become a "hardware supplier" in a traditional sense. Therefore, the institution may opt to provide less support than provided by traditional hardware suppliers.

Fourth, the rubber in the mouse pad may provide an excellent shield against the signals that are emitted from the electronic components in the PCB within the peripheral device. None of these advantages are provided by Wilson.

Partial Inoperability of Proposed Modification

Additionally, the proposed modification of Wilson to incorporate a disk drive in the retractable mouse pad would make the disk drive inoperable whenever the mouse pad is retracted. When the mouse pad is retracted (and thus is "integrated" with the disk drive according to the office action), there is no way to access the disk drive. For Wilson's mouse pad to be operable, it must be extracted from the notebook. Thus the mouse pad would not be "integrated" -- in any sense of the word -- with the notebook in its operable state. The proposed modification of Wilson would thus render the device at least partially inoperable.

Response to Office Action
Ser. No. 09/674,714
May 27, 2003
Page 6

Synergism Not Required for a Patent

The rejection is also based on the supposed lack of a “new and unexpected result” from integration of a read / write device with a mouse pad. But this requirement -- an unexpected synergistic result -- is simply not part of U.S. patent law. *Jervis B. Webb Co. v . Southern Systems, Inc.* 222 USPQ 943, 945 (Fed. Cir. 1984); Robert Harmon, *Patents and the Federal Circuit*, 5th Ed., § 4.2(c), p. 147 (“[i]n case after case, we are told that lack of synergism is not an element of an obviousness determination”). The rejection should be thus be withdrawn because it is based on the legal error that the applicant must show “new and unexpected results” to get a patent.

Conclusion

For the reasons stated above, the present application has not been anticipated or rendered obvious by the cited prior art, and is ready for immediate allowance.

Date: May 27, 2003

By: Daniel P. Maguire
Daniel P. Maguire, Reg. 41,506
Tel: (530) 750-3661